

**REMARKS**

At the time of the Office Action dated October 15, 2004, claims 1-11 were pending and rejected in this application.

**CLAIMS 1-11 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY  
NARIMATSU ET AL., U.S. PATENT NO. 5,892,291 (HEREINAFTER NARIMATSU)**

In the statement of the rejection, the Examiner referred specifically to Fig. 1 and generally to Figs. 1-53 of Narimatsu, and asserted that Narimatsu identically discloses a semiconductor device corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure of each element of a claimed invention in a single reference. As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference. That burden has not been discharged. Moreover, the Examiner neither clearly designated the teachings in Narimatsu being relied upon nor clearly explained the pertinence of Narimatsu. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).<sup>1</sup>

---

<sup>1</sup> 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Claim 1 recites that stepped portions of the inner mark and the outer mark "belong to one same layer." In the statement of the rejection, the Examiner asserted feature 200 of Narimatsu corresponds to the claimed inner mark and feature 100 corresponds to the claimed outer mark. The Examiner also asserted that feature 4 of Narimatsu corresponds to the claimed "one same layer." Referring to Fig. 1(b) of Narimatsu, the asserted inner mark 200A is formed within layer 4 (i.e., resist film) and the asserted outer mark 100A is formed within layer 3 (i.e., interlayer oxide film). Therefore, the asserted inner mark 200A is formed within a completely different level than the asserted outer mark 100A. Although the Examiner has failed to specifically identify the stepped portions of both the asserted inner mark 200A and the asserted outer mark 100A, no portions of the inner and outer marks 200A, 100A belong to one same layer, as recited in claim 1. Therefore, Narimatsu fails to identically disclose the claimed invention, as recited within claim 1.

With regard to claim 11, which recites a photomask used for manufacturing a semiconductor device, the Examiner has failed to establish that Narimatsu teaches a photomask corresponding to that claimed. As discussed in column 9, lines 49-62 of Narimatsu the first measurement mark 100 is formed on a semiconductor substrate 1 and the second measurement mark 200 is formed above the first measure mark 100 with an interlayer oxide film 3 interposed. If, as asserted by the Examiner, the photomask of Narimatsu includes the patterns for both the inner and outer mark, then both an inner and outer mark would be formed on the substrate 1 and the interlayer oxide film 3. However, as illustrated in Fig. 1(b), this does not occur. Therefore, it can be presumed that one photomask was used to form the first measure mark 100 on the interlayer oxide film 3 and a different photomask was used to form the second measure mark 200

on the substrate 1 with neither photomask having both the patterns for the inner mark and the outer mark. Therefore, Narimatsu fails to identically disclose the claimed invention, as recited in claim 11.

For the reasons stated above, Applicant submits that Narimatsu fails to identically disclose the claimed invention, as recited in claims 1-11, within the meaning of 35 U.S.C. § 102. Thus, Applicant respectfully solicits withdrawal of the imposed rejection of claims 1-11 under 35 U.S.C. § 102 for anticipation based upon Narimatsu.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

Application No.: 10/603,738

including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read 'SDP', is written over the printed name of Scott D. Paul.

Scott D. Paul  
Registration No. 42,984

600 13th Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 SDP/AJS:kap  
Facsimile: 202.756.8087  
**Date: December 30, 2004**

**Please recognize our Customer No. 20277  
as our correspondence address.**